

REMARKS

Reconsideration of the objection and the rejections set forth in the Office Action dated May 20, 2005, is respectfully requested. The Examiner rejected claims 1-39. Applicants have canceled claims 1-39 without prejudice and have added new claims 40-78. Accordingly, claims 40-78 remain pending in the application. No new matter has been added by these amendments as can be confirmed by the Examiner.

A. Figure 1 Has Been Amended to Correct Typographical Errors.

The corrected drawings filed on January 21, 2005, include minor typographical errors. Pursuant to 37 C.F.R. § 1.121(a)(3)(ii), a substitute sheet of drawings is hereby submitted for approval by the Examiner with proposed changes in permanent red ink to rectify these errors. The proposed drawing changes are believed to be fully supported by the specification as filed. See, for example, Fig. 1; p. 9, lines 3-16. No new matter has been added by these proposed changes as can be confirmed by the Examiner.

The proposed drawing changes to the corrected drawings include amending the textual description for the reference number 17 from "Internet" to "Communication Link" and changing the textual description for the reference number 12 from "Internet User" to "Provider Computer" in a manner consistent with the specification and original drawing sheets, as filed. Similarly, a central "User Computer 14" is misidentified in the corrected drawings as being an "Internet User 12."

B. The Prior Art Does Not Disclose or Suggest Rendering a Protecting Network Device Unreachable to an Offending Network Device and thereby Inhibiting the Offending Network Device from Clogging an Intermediate Switching System with Problematic Information Packets as Recited in New Claims 40-78.

In the Office Action, the Examiner rejected claim 14 under 35 U.S.C. § 102(e) as allegedly being anticipated by Doi et al., United States Patent No. 6,697,370, and

asserted that claims 1-13 and 15-39 are rendered obvious under 35 U.S.C. § 103(a) by Doi et al. in view of Beigi et al., United States Patent No. 6,363,056, and/or Shanklin et al., United States Patent No. 6,578,147, in view of Putzolu et al., United States Patent No. 6,587,432. Applicants respectfully submit, however that, by failing to disclose each and every element of new independent claims 40, 56, 60, 71, and 77, neither Doi et al., Beigi et al., Shanklin et al., nor Putzolu et al. anticipates or renders obvious new claims 40, 56, 60, 71, and 77. Therefore, it is submitted that new independent claims 40, 56, 60, 71, and 77, as well as new claims 41-55, 57-59, 61-70, 72-76, and 78 that depend respectively thereon, are in condition for allowance.

In contrast to the systems and method recited in new claims 40-78, **none of the cited prior art references**, either individually or in combination, **disclose or suggest a system or method whereby, upon detection of problematic information packets, a protected network device is rendered unreachable such that a suspect network device is prevented from transmitting the problematic information packets to an intermediate switching system**, which is recited in each of the new independent claims. Instead, Shanklin et al., for example, disclose a local computer network 10 that receives and sends data packets via a router 12 and that is protect by an intrusion detection system (IDS) sensor 11. See Shanklin et al. at Fig. 1; col. 3, lines 11-18. According to Shanklin et al., the sensor 11 analyzes the data packets to determine whether traffic into and out from the local network 10 is misused and, upon detecting an intrusion, “can take appropriate action, such as terminating the connection.” See id. at col. 3, lines 61-65 (emphasis added). **The system disclosed by Shanklin et al., therefore, is wholly incapable of preventing the connection from being subsequently re-established and does nothing to inhibit the intermediate router 12 from becoming clogged due to further intrusions.**

The Examiner's reliance on Putzolu et al. likewise is misplaced. As noted by the Examiner in the Office Action, Putzolu et al. disclose a network monitoring agent and a tracing agent for monitoring and analyzing traffic on a network and for detecting a network congestion condition. See Putzolu et al. at col. 1, lines 41-55; col. 3, line 43 - col. 4, line 4. **Neither the network monitoring agent nor the tracing agent taught by Putzolu et al., however, render the protected network device unreachable and prevent the suspect network device from transmitting problematic information packets to an intermediate switching system after detection of the problematic information packets.**

At least one recited element of new claims 40, 56, 60, 71, and 77 therefore is totally missing from Doi et al., Beigi et al., Shanklin et al., and Putzolu et al. In accordance with M.P.E.P. § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). The disclosure of a claim element in a prior art reference, when relied upon to negate patentability, must also be clear and unambiguous. Further, "[t]he identical invention must be shown in as complete detail as contained in the...claim." *Richardson v. Suzuki Motor Corp.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Furthermore, and uniquely important in this case is the requirement that the elements relied on in the prior art reference must be arranged as required by the claim. See *In re Bonds*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Accordingly, since the cited prior art fails to disclose each and every element of independent claims 40, 56, 60, 71, and 77, claims 40-78 are not anticipated. Applicant therefore submits that claims 40-78 are in condition for allowance.

C. No Motivation Exists to Modify the Teachings of Prior Art in a Manner that Precludes the Patentability of New Claims 40-78 Under 35 U.S.C. § 103.

In accordance with M.P.E.P. § 2142, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met." (M.P.E.P. § 2143.) First, some suggestion or motivation in the prior art references or in the knowledge of one of ordinary skill in the relevant art must exist to modify or combine the references. Second, if the references are combined, a reasonable expectation of success must be shown. Then, finally, all of the claim limitations must be taught or suggested by one reference or a combination of references. To establish a *prima facie* case of obviousness based on a single reference that does not teach all the elements of a claim, the Examiner must provide a rationale for modifying the teachings of the reference. See *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000), citing, *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996).


As discussed above with reference to Shanklin et al. and Putzolu et al., at least one recited element of claims 40-78 is totally missing from the cited prior art references. Further, the Examiner does not assert that any teaching or motivation exists in the prior art to modify the prior art in a manner that renders new claims 40-78 obvious. The Examiner therefore has not established a *prima facie* case under 35 U.S.C. § 103 because, as shown above, all of the elements of the pending claims are not found in the cited references. According, it is submitted that the cited prior art does not anticipate or render obvious new independent claims 40, 56, 60, 71, and 77. Applicant therefore submits that claims 40, 56, 60, 71, and 77, as well as claims 41-55, 57-59, 61-70, 72-76, and 78 that depend respectively thereon, are in condition for allowance.

For at least the reasons set forth above, it is submitted that new claims 40-78 are in condition for allowance. A Notice of Allowance is earnestly solicited. The Examiner is encouraged to contact the undersigned at (949) 567-6700 if there is any way to expedite the prosecution of the present application.

Respectfully submitted,

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